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Subject: U.S. Trademark Application Serial No. 88458681 - OPTCONNECT MANAGED WIRELESS - N/A - EXAMINER BRIEF

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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial Nos.** 88458681 and 88458653

**Mark:** OPTCONNECT MANAGED WIRELESS and  
OPTCONNECT

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**Reference/Docket No.** N/A

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**EXAMINING ATTORNEY’S CONSOLIDATED APPEAL BRIEF**

**I. Introduction**

The applicant, OptConnect Management, LLC, has appealed a final refusal to register the marks OPTCONNECT and OPTCONNECT MANAGED WIRELESS SOLUTIONS [and design] for use with:

Class 9: Machine-to-machine (M2M) device networking products, namely, modems, network routers, computer network adaptors, network power controllers, antennae, and amplifiers designed to facilitate machine-to-machine communications with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; computer hardware for running firmware or software designed to facilitate machine-to-machine (M2M) communications and interfaces with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; microcontrollers and remote control transmitters designed for internet of things (IoT) enabled remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; downloadable software designed for connecting, operating and managing machine to machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment

Class 38: Providing machine to-machine (M2M) connectivity over long distances and remote locations with unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing electronic transmission of data and information to wirelessly connected machine-to-machine (M2M), network-connected, and Internet connected remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self service retail point-of-sale devices, and agricultural equipment comprising the Internet of things (IoT); technical consulting in the field of electronic and digital data transmission and communication via machine to machine (m2m) technology, remote device management and the internet of things (IoT) related to unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment

Class 42: Providing on-line nondownloadable software designed for connecting, operating and managing machine to machine (m2m) services for remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-

service retail point-of-sale devices, and agricultural equipment; providing a web portal featuring technological information and technology to monitor and manage connectivity, usage, management, and provisioning of machine- to-machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self service retail point-of-sale devices, and agricultural equipment, and to provide reporting data and diagnostics and monitor the location of such devices; providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet

The examining attorney refused registration of the applied-for marks based on a likelihood of confusion between the applied-for marks and the mark in Reg. No. 3914101, OPCONNECT in standard characters, which has been registered for use with “[i]nteractive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging” in Class 9.

## II. Facts

On June 4, 2019, the applicant filed application Ser. Nos. 88458653 and 88458681 for registration on the Principal Register of the respective marks OPTCONNECT in standard characters and OPTCONNECT MANAGED WIRELESS SOLUTIONS together with an abstract design consisting of interlocking shapes:



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<sup>1</sup> To ensure brevity and avoid duplication, the original identification is omitted here.

The trademark examining attorney refused registration on September 4, 2019 based on a likelihood of confusion with the mark OPCONNECT in Reg. No. 3914101. The examining attorney also issued a requirement to amend the identifications of goods and services and, in the case of Ser. No. 88458681, requirements to disclaim the descriptive wording MANAGED WIRELESS SOLUTIONS and to submit a clear drawing of the mark.

On March 4, 2020 applicant responded to the initial office actions, arguing against the refusal under Section 2(d) and resolving all of the requirements except the requirement to provide a clear drawing of the mark in the case of Ser. No. 88458681.

Unpersuaded by the arguments put forward by the applicant, the examining attorney made the refusals under Section 2(d) final on April 2, 2020, as well as making final the requirement in the case of Ser. No. 88458681 to provide a clear mark drawing.

Applicant filed a request for reconsideration, and appeal, on October 2, 2020, making similar arguments against the Section 2(d) refusals and minor amendments to a portion of the identifications. Additionally, a clear mark drawing was provided as to Ser. No. 88458681, satisfactorily resolving that requirement.

Still unpersuaded by the repetition of largely the same arguments previously advanced and the minor amendments to the identifications, the examining attorney denied the request for reconsideration on November 12, 2020 and the case was returned to the Board for resumption of the appeal.

On February 16, 2021, the applicant, after requesting that the case be remanded so as to make further amendments to the identifications of goods and services, filed another request for reconsideration.

Finding the applicant's largely duplicative arguments unpersuasive, even in light of the further amendments to the identifications of goods and services, the examining attorney again refused the request for reconsideration of the refusals under Section 2(d) and the case was returned to the Board for resumption of the appeal.

The applicant submitted its appeal briefs in these cases on April 30, 2020. In light of the common issues of law and fact, the cases were consolidated into a single appeal and therefore this brief addresses both applications.

For the reasons set forth below, the examining attorney respectfully requests that the Trademark Trial and Appeal Board affirm the refusal to register the applied-for marks pursuant to Section 2(d) of the Trademark Act.

### **III. Issue**

The sole issue in these appeals is whether the applied-for marks are so similar to the registered mark that, when used in connection with the Applicant's goods and services, it is likely to cause confusion, to cause mistake, or to deceive as to the source of the goods and services under Trademark Act Section 2(d).

### **IV. Argument**

**There is likelihood of confusion between the applied-for and registered marks because the marks are confusingly similar and the goods and services of the parties are related.**

Trademark Act Section 2(d) bars registration of an applied-for mark that is so similar to a registered mark that it is likely consumers would be confused, mistaken, or deceived as to the commercial source of the goods and services of the parties. See 15 U.S.C. §1052(d). Likelihood of confusion is determined on a case-by-case basis by applying the factors set forth in *In re E. I. du Pont de*

*Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973) (called the “*du Pont* factors”). *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017). Any evidence of record related to those factors need be considered; however, “not all of the *DuPont* factors are relevant or of similar weight in every case.” *In re Guild Mortg. Co.*, 912 F.3d 1376, 1379, 129 USPQ2d 1160, 1162 (Fed. Cir. 2019) (quoting *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)).

Although not all *du Pont* factors may be relevant, there are generally two key considerations in any likelihood of confusion analysis: (1) the similarities between the compared marks and (2) the relatedness of the compared goods and services. See *In re i.am.symbolic, llc*, 866 F.3d at 1322, 123 USPQ2d at 1747 (quoting *Herbko Int’l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 1103, 192 USPQ 24, 29 (C.C.P.A. 1976) (“The fundamental inquiry mandated by [Section] 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods [or services] and differences in the marks.”); TMEP §1207.01.

*a. The marks, viewed in the entirety, are highly similar in at least sound and appearance and are therefore confusingly similar*

Marks are compared in their entirety for similarities in appearance, sound, connotation, and commercial impression. *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d 1317, 1321, 110 USPQ2d 1157, 1160 (Fed. Cir. 2014) (quoting *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondee En 1772*, 396 F.3d 1369, 1371, 73 USPQ2d 1689, 1691 (Fed. Cir. 2005)); TMEP §1207.01(b)-(b)(v). “Similarity in any one of these elements may be sufficient to find the marks confusingly similar.” *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re Davia*, 110 USPQ2d 1810, 1812 (TTAB 2014)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

The applicant’s argument that the registered mark is entitled to a narrow scope of protection falls foul of the basic principle noted above that marks are compared in the entirety. The applicant’s

argument is that there are numerous, what it terms, “CONNECT-formative marks” on the Register and in the marketplace. There are in fact many marks for similar goods and services that include the wording CONNECT, but the marks here are not confusingly similar because they contain the wording CONNECT alone, but when viewed in their entireties, as set forth below.

When comparing marks, “[t]he proper test is not a side-by-side comparison of the marks, but instead whether the marks are sufficiently similar in terms of their commercial impression such that [consumers] who encounter the marks would be likely to assume a connection between the parties.” *Cai v. Diamond Hong, Inc.*, 901 F.3d 1367, 1373, 127 USPQ2d 1797, 1801 (Fed. Cir. 2018) (quoting *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1368, 101 USPQ2d 1713, 1721 (Fed. Cir. 2012)); TMEP §1207.01(b). The proper focus is on the recollection of the average purchaser, who retains a general rather than specific impression of trademarks. *In re Inn at St. John’s, LLC*, 126 USPQ2d 1742, 1746 (TTAB 2018) (citing *In re St. Helena Hosp.*, 774 F.3d 747, 750-51, 113 USPQ2d 1082, 1085 (Fed. Cir. 2014); *Geigy Chem. Corp. v. Atlas Chem. Indus., Inc.*, 438 F.2d 1005, 1007, 169 USPQ 39, 40 (C.C.P.A. 1971)), *aff’d per curiam*, 777 F. App’x 516, 2019 BL 343921 (Fed. Cir. 2019); TMEP §1207.01(b).

#### Ser. No. 88458653

The mark in Ser. No. 88458653 is OPTCONNECT in standard characters and the registered mark is OPCONNECT in standard characters. The marks differ only in the letter T between the letters OP and the wording CONNECT. The applicant has submitted evidence that the wording OP and OPT have different meanings as acronyms and uses this to claim that the marks have different commercial impressions. However, there is no evidence to support the conclusion that consumers would read into the wording OP or OPT any of the meanings alleged by applicant and therefore the distinction between the wording is not one that consumers are likely to note, let alone lead consumers to ignore the similarities between the marks and conclude that the marks signify different sources.

In this case, the letter T in OPT is likely to be elided such that OPTCONNECT is pronounced the same, or very nearly, as OPCONNECT. Similarity in sound alone may be sufficient to support a finding



that the compared marks are confusingly similar. *In re 1st USA Realty Prof'ls, Inc.*, 84 USPQ2d 1581, 1586 (TTAB 2007) (citing *Krim-Ko Corp. v. Coca-Cola Bottling Co.*, 390 F.2d 728, 732, 156 USPQ 523, 526 (C.C.P.A. 1968)); TMEP §1207.01(b)(iv). Further, slight differences in the sound of similar marks will not avoid a likelihood of confusion. *In re Energy Telecomms. & Elec. Ass'n*, 222 USPQ 350, 351 (TTAB 1983); see *In re Viterra Inc.*, 671 F.3d 1358, 1367, 101 USPQ2d 1905, 1912 (Fed. Cir. 2012).

Thus, the marks are likely to be pronounced the same or very similarly. The marks are also similar in appearance as both begin with OP and end in CONNECT. Finally, consumers are likely to not notice, let alone place significant emphasis, on the letter T and the specific possible meanings of OP vs. OPT.

Overall, the marks are highly similar in sound and appearance, without a significant difference between the marks' meanings to distinguish the marks in the minds of consumers and especially to alter the general impression that remains in the recollection of the average purchaser.

#### Ser. No. 88458681

In the case of the mark in Ser. No. 88458681, although the mark includes additional matter, the dominant element of the mark is the wording OPTCONNECT, as discussed below.

Although marks are compared in their entireties, one feature of a mark may be more significant or dominant in creating a commercial impression. See *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). Greater weight is often given to this dominant feature when determining whether marks are confusingly similar. See *In re Detroit Athletic Co.*, 903 F.3d at 1305, 128 USPQ2d at 1050 (citing *In re Dixie Rests.*, 105 F.3d at 1407, 41 USPQ2d at 1533-34). In this case, the largest element of the applied-for mark is the wording OPTCONNECT, with all of the other elements appearing less prominently.

When evaluating a composite mark consisting of words and a design, the word portion is normally accorded greater weight because it is likely to make a greater impression upon purchasers, be remembered by them, and be used by them to refer to or request the goods and services. *In re Aquitaine Wine USA, LLC*, 126 USPQ2d 1181, 1184 (TTAB 2018) (citing *In re Viterro Inc.*, 671 F.3d 1358, 1362, 101 USPQ2d 1905, 1908 (Fed. Cir. 2012)); TMEP §1207.01(c)(ii). Thus, although marks must be compared in their entireties, the word portion is often considered the dominant feature and is accorded greater weight in determining whether marks are confusingly similar, even where the word portion has been disclaimed. *In re Viterro Inc.*, 671 F.3d at 1366-67, 101 USPQ2d at 1911 (citing *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1570-71, 218 USPQ2d 390, 395 (Fed. Cir. 1983)). In this case, this means that the wording in the applied-for mark is accorded greater weight than the “abstract design consisting of interlocking shapes” also in the mark.

A mark in typed or standard characters may be displayed in any lettering style; the rights reside in the wording or other literal element and not in any particular display or rendition. *See In re Viterro Inc.*, 671 F.3d 1358, 1363, 101 USPQ2d 1905, 1909 (Fed. Cir. 2012); *In re Mighty Leaf Tea*, 601 F.3d 1342, 1348, 94 USPQ2d 1257, 1260 (Fed. Cir. 2010); 37 C.F.R. §2.52(a); TMEP §1207.01(c)(iii). Thus, a mark presented in stylized characters and/or with a design element generally will not avoid likelihood of confusion with a mark in typed or standard characters because the word portion could be presented in the same manner of display. *See, e.g., In re Viterro Inc.*, 671 F.3d at 1363, 101 USPQ2d at 1909; *Squirtco v. Tomy Corp.*, 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983) (stating that “the argument concerning a difference in type style is not viable where one party asserts rights in no particular display”). Because the registered mark is in standard characters, the stylization of the wording in the applied-for mark does not avoid the likelihood of confusion between the marks, or significantly alter the analysis when comparing the marks.

Disclaimed matter that is descriptive of or generic for a party's goods and services is typically less significant or less dominant when comparing marks. *In re Detroit Athletic Co.*, 903 F.3d 1297, 1305, 128 USPQ2d 1047, 1050 (Fed. Cir. 2018) (citing *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997)); TMEP §1207.01(b)(viii), (c)(ii). In this case, the wording MANAGED

WIRELESSOLUTIONS is merely descriptive of the goods and services in the application, as shown by evidence attached to the initial office action, and applicant has disclaimed the wording, rendering OPTCONNECT the dominant literal element of the mark.

Additionally, consumers are generally more inclined to focus on the first word, prefix, or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005) (finding similarity between VEUVE ROYALE and two VEUVE CLICQUOT marks in part because “VEUVE . . . remains a ‘prominent feature’ as the first word in the mark and the first word to appear on the label”); *Century 21 Real Estate Corp. v. Century Life of Am.*, 970 F.2d 874, 876, 23 USPQ2d 1698, 1700 (Fed Cir. 1992) (finding similarity between CENTURY 21 and CENTURY LIFE OF AMERICA in part because “consumers must first notice th[e] identical lead word”); see also *In re Detroit Athletic Co.*, 903 F.3d 1297, 1303, 128 USPQ2d 1047, 1049 (Fed. Cir. 2018) (finding “the identity of the marks’ two initial words is particularly significant because consumers typically notice those words first”). Here, the first word of the applied-for mark is the wording OPTCONNECT.

As the first, largest, and only non-descriptive word element of the mark, the dominant element of the mark in Ser. No. 88458681 is the lightly stylized wording OPTCONNECT. Thus, essentially the same analysis applies to this mark and the registered mark as applied to the registered mark and the mark in Ser. No. 88458653 in weighing the similarity of the marks.

Both of the applied-for marks, which are in their dominant element or entirety the wording OPTCONNECT, are highly similar in at least sound and appearance to the registered mark, which is OPCONNECT. Accordingly, the marks are confusingly similar.

*b. The evidence in the record demonstrates that the goods and services in the applications are related to the goods in the registration*

The goods in the registration are:

Class 9: Interactive computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising and electric vehicle charging

The goods and services in the applications are:

Class 9: Machine-to-machine(M2M) device networking products, namely, modems, network routers, computer network adaptors, network power controllers, antennae, and amplifiers designed to facilitate machine-to-machine communications with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; computer hardware for running firmware or software designed to facilitate machine-to-machine (M2M) communications and interfaces with remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; microcontrollers and remote control transmitters designed for internet of things (IoT) enabled remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; downloadable software designed for connecting, operating and managing machine to machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment

Class 38: Providing machine to-machine (M2M) connectivity over long distances and remote locations with unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing electronic transmission of data and information to wirelessly connected machine-to-machine (M2M), network-connected, and Internet connected remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self service retail point-of-sale devices, and agricultural equipment comprising the Internet of things (IOT); technical consulting in the field of electronic and digital data

transmission and communication via machine to machine (m2m) technology, remote device management and the internet of things (IoT) related to unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment

Class 42: Providing on-line nondownloadable software designed for connecting, operating and managing machine to machine (m2m) services for remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment; providing a web portal featuring technological information and technology to monitor and manage connectivity, usage, management, and provisioning of machine- to-machine (m2m) remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self service retail point-of-sale devices, and agricultural equipment, and to provide reporting data and diagnostics and monitor the location of such devices; providing remote management and monitoring technological functions of remote unattended automated teller machines, cash automation systems, commercial laundry equipment, vending machines, self-service retail point-of-sale devices, and agricultural equipment via computer networks, wireless networks or the Internet

The goods and services are compared to determine whether they are similar, commercially related, or travel in the same trade channels. See *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356, 1369-71, 101 USPQ2d 1713, 1722-23 (Fed. Cir. 2012); *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1165, 64 USPQ2d 1375, 1381 (Fed. Cir. 2002); TMEP §§1207.01, 1207.01(a)(vi).

The compared goods and services need not be identical or even competitive to find a likelihood of confusion. See *On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); TMEP §1207.01(a)(i). They need only be “related in some manner and/or if the circumstances surrounding their marketing are such that they could give rise to the mistaken belief that [the goods and services] emanate from the same source.” *Coach Servs., Inc. v. Triumph Learning LLC*, 668 F.3d 1356,

1369, 101 USPQ2d 1713, 1722 (Fed. Cir. 2012) (quoting *7-Eleven Inc. v. Wechsler*, 83 USPQ2d 1715, 1724 (TTAB 2007)); TMEP §1207.01(a)(i).

Generally, the greater degree of similarity between an applied-for mark and the registered mark, the lesser the degree of similarity between the goods and services of the parties is required to support a finding of likelihood of confusion. *In re C.H. Hanson Co.*, 116 USPQ2d 1351, 1353 (TTAB 2015) (citing *In re Opus One Inc.*, 60 USPQ2d 1812, 1815 (TTAB 2001)); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1636 (TTAB 2009). As discussed above, the marks here are highly similar.

The fact that the goods and services of the parties differ is not controlling in determining likelihood of confusion. The issue is not likelihood of confusion between particular goods and services, but likelihood of confusion as to the source or sponsorship of those goods and services. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1316, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003); *In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993); TMEP §1207.01.

Determining likelihood of confusion is based on the description of the goods and services stated in the application and registration at issue, not on extrinsic evidence of actual use. *See In re Detroit Athletic Co.*, 903 F.3d 1297, 1307, 128 USPQ2d 1047, 1052 (Fed. Cir. 2018) (citing *In re i.am.symbolic, llc*, 866 F.3d 1315, 1325, 123 USPQ2d 1744, 1749 (Fed. Cir. 2017)). The applicant's arguments, which rely heavily on its own and registrant's websites to define the scope of the parties' respective goods and services, fails to heed this important point.

The applicant's brief (in particular the introduction), as well as applicant's responses and requests for reconsideration all attempt to present a general or colloquial statement of what applicant's goods and services are and fall afoul of the principle that the likelihood of confusion is not based on extrinsic evidence of actual use. The applicant's characterization distorts and distracts from the relevant question, which is whether the goods and services actually set forth in the identifications of goods and services in the applications and registration are related.

As an initial matter, the applicant's brief demonstrates a fundamental misreading of the identification set forth in the registration. The applicant repeatedly limits the identification in the registration to being a "kiosk...for use in... electric vehicle charging". This completely ignores the other main function of the goods in the application "computer kiosks comprising computers, computer hardware, computer peripherals, and computer operating software, for use in digital advertising". To read the identification in the registration as limiting registrant's goods to only kiosks that are used simultaneously and exclusively for both digital advertising and electric vehicle charging is unsupported grammatically (the use of the word "and" merely denotes that the kiosks and their components have two main fields of use that may or may not overlap). Additionally, to accept the applicant's logic would require reading into the applicant's identification of goods and services that the goods and services are for use in each of the disparate fields of use, all at the same time; that is, that the applicant's goods are for use only in some device or system that is both simultaneously an automated teller machine and agricultural equipment, as well as having all the other functions set forth in the identifications. This misreading of the identification leads the applicant to dramatically narrow the scope of the registration.

Not only does the applicant misread the identification of goods in the registration, it also reads a narrowness and specificity into its own identification of goods and services that is not actually present. The identification in fact sets forth broad wording for many of applicant's goods and services, including essentially "computer hardware", "computer software" and "non-downloadable software", "providing...connectivity", "providing electronic transmission of data and information" in various fields that essentially are just for connecting electronic devices and therefore include a wide range of goods and services that actually appear in the marketplace.

The evidence demonstrates that the goods and services in the applications and registration are at least complementary in terms of use or function as the goods and services would be used and/or bought together. The evidence demonstrates that electric vehicle charging installations are frequently, and often necessarily, connected to the internet of things and to other devices. Specifically:

- ABB offers both electric vehicle charging devices as well as software and connectivity and monitoring services. September 4, 2019 Office Action, p. 8-13.

- Evidence from Greenlots and Charge Point demonstrates that electric vehicle charging installations are commonly connected using computer hardware and software. September 4, 2019 Office Action, p. 14-28; 29-36.
- Evidence from Etteplan More, Soften GI, Government Europa, Schneider Electric, EV Box, IoTecha, and Enel X further demonstrates that electric vehicle charging installations often are connected to the internet of things using device networking products and utilize software services for their control. November 12, 2020 Denial of Request for Reconsideration, p. 12-17, 18-26; April 2, 2020 Final Action, p. 47-51, 52-72, 73-97, 98-103, 104-135.
- Eseye provides device networking products including computer hardware for connecting devices to the internet of things as well as management software for use at least with electric vehicle charging installations. November 12, 2020 Denial of Request for Reconsideration, p. 27-62.
- Uرسالink provides device networking products, in particular routers and modems, for use in at least electric vehicle charging and agricultural monitoring as well as remote management software. November 12, 2020 Denial of Request for Reconsideration, p. 63-89.
- Evidence from Siretta and Tele2 shows that machine to machine and internet of things device networking products, such as modems, and software are commonly used to connect, operate, and manage electric vehicle charging installations. November 12, 2020 Denial of Request for Reconsideration, p. 90-94; 95-103.
- Applicant's webpage demonstrates that it provides its goods and services for use in connection with "kiosk[s]" and "EV charging". November 12, 2020 Denial of Request for Reconsideration, p. 104-134. This evidence demonstrates not that the goods and services in the applications are for use with "kiosk[s]" and "EV charging", but that entities that offer the goods and services in the application also offer them for use in these applications as well.

Thus, registrant's interactive kiosks for electric vehicle charging commonly contain device networking products and computer hardware such as those offered by the applicant (while the application may not set forth electric vehicle charging as a field of use for the goods and services, the evidence shows that entities that offer the goods and services for use in the fields that applicant does specify also frequently offer them for the field of electric vehicle charging). Entities commonly provide connectivity, data transmission, software, and remote monitoring and management services for devices such as registrant's interactive kiosks. An entity offering registrant's charging installations, under for



example the mark OPCONNECT, may then advertise them as containing, featuring, or being suitable for use with the networking devices and services of another entity, for example OPTCONNECT. In this context at least, consumer confusion is likely.

Applicant provides the software, computer hardware, and services commonly used in connecting registrant's devices to the internet of things. The argument that consumers will be able to distinguish different sources from the mark OPCONNECT on the kiosk and OPTCONNECT with, for example, the software that lets users monitor or manage the kiosks, is simply unpersuasive.

As to the other main function of registrant's goods, the evidence shows that "[i]nteractive computer kiosks...for use in digital advertising" come in many forms, including those that both advertise and sell goods and come in the form of "vending machines [or] self-service retail point-of-sale devices" which also provide digital advertising. Thus, the uses or applications of the goods and services of the applicant and registrant are not as distinct as the applicant asserts.

Similarly to registrant's devices for electric vehicle charging, the evidence demonstrates that entities that offer network connectivity devices and services, such as those set forth in the applications, offer the goods and services for use in connection with digital signage and advertising as well as for use with other types of kiosks. Specifically:

- Cradlepoint offers both device networking products, in particular routers, for use with, among other functions, "surveillance cameras, digital signs, [and] oil and gas monitoring", as well as management software services for a variety of functions, including digital signage, kiosks, and ATMs. April 2, 2020 Final Action, p. 8-33.
- Evidence from Wirespring demonstrates that interactive kiosks, including those for use with digital signage, commonly utilize device networking components to support their functions for a wide variety of applications, "including retail, automotive, education, food service, and banking", and can be controlled remotely and via a "web-based management system". April 2, 2020 Final Action, p. 34-40.

- Meridian offers both interactive kiosks and software as well as providing electronic transmission of data, and software for remote management. April 2, 2020 Final Action, p. 136-155.
- Eseye provides device networking products including computer hardware for connecting devices to the internet of things as well as management software for use at least with retail or vending installations. November 12, 2020 Denial of Request for Reconsideration, p. 27-62.
- Applicant's webpage demonstrates that it provides its goods and services for use in connection with "digital signage" and "kiosk[s]". November 12, 2020 Denial of Request for Reconsideration, p. 104-134. Again, this evidence demonstrates not that the goods and services in the applications are for use with "digital signage" and "EV charging", but that entities that offer the goods and services in the application also offer them for use in these applications as well.
- Evidence from Wirespring further demonstrates that "software and cloud services" such as those in the application are commonly used to connect and support "digital signage" and machine to machine and internet of things functions. November 12, 2020 Denial of Request for Reconsideration, p. 135-150.
- Evidence from Screenly and e-Spirit shows that applicant's software and web portals for connecting, managing, and monitoring internet of things and machine to machine devices are commonly used in connection with digital signage. November 12, 2020 Denial of Request for Reconsideration, p. 151-163 and 164-169.
- Digi provides device networking products such as routers, computer hardware, remote management and monitoring software, and networking services for numerous industries and applications, including for digital signage. November 12, 2020 Denial of Request for Reconsideration, p. 170-209.
- Novosign provides device networking products, computer hardware, and software for internet of things devices and in particular for use with digital signage and kiosks. November 12, 2020 Denial of Request for Reconsideration, p. 210-214.
- Spinetix provides device networking products and computer hardware and software for use in digital signage as well as a "web portal" for monitoring the devices. November 12, 2020 Denial of Request for Reconsideration, p. 257-268.
- Senslynx "offers integrated bundle solutions that includes Hardware, Software and Connectivity" for use with, among other functions, "digital signage", "retail/point-of-sale", and "ATM & Kiosks", including routers and "networking monitoring and management tools". November 12, 2020 Denial of Request for Reconsideration, p. 269-276.

- Inhand Networks provides routers for use in digital signage as well as a “cloud platform” to “manage the[] network efficiently”. November 12, 2020 Denial of Request for Reconsideration, p. 277-286.
- Coreco M2M demonstrates that IOT and M2M modems are commonly used in “POS & Kiosk” and “vending machine” functions as well as for use with digital signage. November 12, 2020 Denial of Request for Reconsideration, p. 287-297.
- Adaptive Modules offers device networking products such as modems and routers for use in digital signage and kiosks. November 12, 2020 Denial of Request for Reconsideration, p. 298-324.
- DH Wireless Solutions demonstrates that M2M devices such as antennas, boosters, routers, and modems are commonly used in systems such as digital signage systems and connected kiosks. November 12, 2020 Denial of Request for Reconsideration, p. 325-336.
- ATT offers interactive digital signage as well as selling routers and offering connectivity and management services and software for the internet of things. November 12, 2020 Denial of Request for Reconsideration, p. 337-384.
- Cisco offer digital signage products, including both computer hardware and software applications for the control and management of the signage as well as routers for the internet of things. November 12, 2020 Denial of Request for Reconsideration, p. 385-466.
- Verizon offers digital signage devices as well as management software and connectivity services for internet of things devices. November 12, 2020 Denial of Request for Reconsideration, p. 482-502.

Consumers and users of registrant’s computer kiosks for digital advertising will be confronted with the devices, hardware, and software, connectivity, and transmission services of the applicant because these are often fundamental features and components of the former. A purchaser of a kiosk commonly connected to the internet of things will likely be made aware of the goods and services that make that connection possible, whether these be components or compatible systems that the purchaser can use with or incorporate into the kiosk. Consumer confusion is likely when the mark OPCONNECT is used in connection with a computer kiosk performing digital advertising functions, which are commonly connected to the internet of things, and the OPTCONNECT is used with the goods and services that make connection to the internet of things possible for similar installations.

Applicant contends that the goods and services are not related because applicant's goods are "component[s] of other devices" and registrant's goods are "a finished product" and therefore there cannot be a likelihood of confusion. This is incorrect for several reasons. First, finished products often note that they feature certain components and therefore the mark for the components or software used to support or connect the finished product may appear on the finished products themselves or in advertising the compatibility of the goods with systems for connecting the devices. In this case, the evidence shows that computer kiosks and installations for digital advertising and electric vehicle charging are commonly connected to the internet of things or to other machine to machine devices.

The use of the mark OPTCONNECT in connection with goods and services used to connect devices to the internet of things and the use of the mark OPCONNECT on devices that are commonly connected to the internet of things to support their key functionality, is likely to engender confusion among the users and consumers of the goods and services as to the source of those specific features or applications of the goods and services.

Thus, the evidence shows that the goods and services operate in the same general fields and are complementary in terms of their functions. Consumers confronting the goods of the registrant are also likely to be exposed to the goods and services of the applicant and be confused as to the source of the respective goods and services.

Finally, "[l]ikelihood of confusion must be found if there is likely to be confusion with respect to any item in a class that comes within the identification of goods [or services] in the application and cited registration." *In re i.am.symbolic, llc*, 116 USPQ2d 1406, 1409 (TTAB 2015); *See Tuxedo Monopoly, Inc. v. General Mills Fun Group*, 648 F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Apple Computer v. TVNET.Net, Inc.*, 90 USPQ2d 1393, 1398 (TTAB 2007). Therefore, if the Board finds a likelihood of confusion with respect to any of the goods or services in the applications in a particular class, then a likelihood of confusion should be found with respect to all of the goods or services in the respective class.

c. *The applicant's argument that the goods and services are offered in different channels of trade and to different classes of consumers is unpersuasive*

The applicant's arguments regarding the channels of trade in which the goods and services of the parties are offered again reads limitations and restrictions into the identifications of goods and services that are simply not present. Contrary to applicant's assertions, it is not "obvious from OptConnect's identification of goods that its products are not consumer products" and there are no limitations in the identification as to the customers or users of the goods and services.

The presumption under Trademark Act Section 7(b) is that the registrant is the owner of the mark and that their use of the mark extends to all goods identified in the registration. 15 U.S.C. §1057(b). In the absence of limitations as to channels of trade or classes of purchasers in the goods and in the registration, the presumption is that the goods move in all trade channels normal for such goods and are available to all potential classes of ordinary consumers of such goods. See *In re I-Coat Co.*, 126 USPQ2d 1730, 1737 (TTAB 2018); *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(a)(iii). The same is true when reading the identification of goods and services in the application, which is devoid of any limitation as to the channels of trade or classes of purchasers.

d. *The purported sophistication of the relevant consumers does not obviate the likelihood of confusion*

The fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); see, e.g., *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. 1317, 1325, 110 USPQ2d 1157, 1163-64 (Fed. Cir. 2014); *Top Tobacco LP v. N. Atl. Operating Co.*, 101 USPQ2d 1163, 1170 (TTAB 2011). Further, where the purchasers consist of both professionals and the public, the standard of care for purchasing the goods is that of the least sophisticated potential purchaser. *In re FCA US LLC*, 126 USPQ2d 1214, 1222 (TTAB 2018) (citing *Stone Lion Capital Partners, LP v. Lion Capital LLP*, 746 F.3d. at 1325, 110 USPQ2d at 1163), *aff'd per curiam*, 777 F. App'x 516, 2019 BL 375518 (Fed. Cir. 2019). Additionally, as noted above, while the applicant

may be offering its goods and services to very specific customers, the identification of goods and services is not actually limited in that fashion. The applicant's argument that its customers are sophisticated, does not show that purchasers of the goods and services in the application and registration are necessarily sophisticated. The distinction between what the applicant is, in the 'real world', offering and how it does so and what entities that offer the goods and services in the identifications again leads the applicant to read what is in fact a broadly worded identification as something much more narrow.

e. *The applicant's arguments regarding a purported absence of actual confusion and co-existence of the marks are of minimal significance*

The mere allegation that the marks may have co-existed for a period of time in the marketplace is unpersuasive. "[A] showing of actual confusion is not necessary to establish a likelihood of confusion." *In re i.am.symbolic, llc*, 866 F.3d 1315, 1322, 123 USPQ2d 1744, 1747 (Fed. Cir. 2017) (quoting *Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002)); TMEP §1207.01(d)(ii). "[T]he relevant test is *likelihood* of confusion, not *actual* confusion." *In re Detroit Athletic Co.*, 903 F.3d 1297, 1309, 128 USPQ2d 1047, 1053 (Fed. Cir. 2018) (emphasis in original). "Uncorroborated statements of no known instances of actual confusion . . . are of little evidentiary value," especially in ex parte examination. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1317, 65 USPQ2d 1201, 1205 (Fed. Cir. 2003).

Further, the claim that the marks have co-existed for a period of time and therefore the applicant is entitled to a registration constitutes an attack on the validity and purpose of the cited registration. Trademark Act Section 7(b), 15 U.S.C. §1057(b), provides that a certificate of registration on the Principal Register is prima facie evidence of the validity of the registration, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the mark in commerce on or in connection with the goods and/or services specified in the certificate. During ex parte prosecution, the trademark examining attorney has no authority to review or to decide on matters that constitute a collateral attack on the cited registration. TMEP §1207.01(d)(iv).

*f. Doubt is resolved in favor of the Registrant*

The overriding concern is not only to prevent buyer confusion as to the source of the goods and services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1026 (Fed. Cir. 1988).

**V. Conclusion**

The applied-for marks and the registered mark are overall highly similar in at least sound and appearance and are therefore confusingly similar. Further, the goods and services of the parties are related in terms of their use or application and similar goods and services are likely to appear together in the marketplace. A lack of evidence of actual confusion and purported, though unestablished, sophistication of the consumers of the goods and services carry little weight in the inquiry of whether there is a likelihood of confusion. Therefore, the most relevant *du Pont* factors in this case, the similarity of the marks and the relatedness of the parties' goods and services, weigh heavily in favor of a likelihood of confusion between the applied-for and registered marks.

For the reasons explained above, the examining attorney respectfully requests that the refusal to register the applied-for marks under Section 2(d) be affirmed.

Respectfully submitted,

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